

REMARKS

Reconsideration of this application is respectfully requested.

Claims 53-56 are pending.

Priority

The Office contended that the amendment to the specification submitted on September 8, 2005, incorrectly set forth the claim for benefit of priority. (Office Action at item 3.) In particular, the Office contended that the amendment should have indicated that the instant application was a national stage application of PCT International Application No. PCT/IB99/00740. (Office Action at item 3.) Additionally, the Office noted that the Substitute Declaration filed December 6, 2001, did not designate the instant application as a § 371 application, and instead claimed priority to the PCT Application under 35 U.S.C. § 119. (Office Action at item 3.) The Office indicated that the Substitute Declaration conflicted with the Original Declaration, making it unclear if Applicants intended to change the status of the instant application from a § 371 national stage application to an application filed under 35 U.S.C. § 111(a). (Office Action at item 3.)

Additionally, the Office contended that because the application claimed the benefit under 35 U.S.C. § 120 of U.S. Application No. 09/060,756, the Application must indicate the relationship to the priority application. (Office Action at item 3.)

To correct any perceived inconsistencies and to facilitate prosecution of this application, Applicants have (1) amended the first paragraph of the specification and (2) submitted a Supplemental Application Data Sheet herewith.

The first paragraph of the specification now reads, "This divisional application is a national stage application of PCT International Application No. PCT/IB99/00740, filed April 16, 1999, and claims the benefit under 35 U.S.C. § 120 of U.S. Application No. 09/060,756, filed April 16, 1998, now issued U.S. Patent No. 6,183,957."

The Supplemental Application Data Sheet filed herewith indicates in the "Prior U.S. Applications" section that the instant application claims the benefit of U.S. Application No. 09/060,756, filed April 16, 1998. Additionally, the Supplemental Application Data Sheet shows PCT/IB99/00740, filed April 16, 1999, in strikethrough format in the "Prior Foreign Applications" section. Strikethrough format was used, as instructed at 37 C.F.R. 1.76(d), to show the discrepancy with the Substitute Declaration filed December 6, 2001.

Applicants respectfully submit that the amended specification properly sets forth the benefit claim, and also sets forth the relationship between the instant application and U.S. Application No. 09/060,756. Moreover, Applicants respectfully submit that this paragraph is consistent with the information provided in the Application Data Sheet. In view of these actions, Applicants respectfully request that the Office acknowledge the benefit claim, withdraw the rejection under 35 U.S.C. § 102(a), and allow the pending claims.

Double Patenting

The Office maintained the obviousness-type double patenting rejection over claims 9-11 and 13 of U.S. Patent No. 6,183,957 ("the '957 patent"). (Office Action at items 7-8.) The Office contends that the pending claims are directed to purified polynucleotides comprising an open reading frame within SEQ ID NO: 1, while claims 9-

11 and 13 of the '957 patent are directed to purified polynucleotides isolated by a hybridization method that the specification teaches was used to isolate SEQ ID NO: 1. (Office Action at item 7.) The Office contends that the pending claims are therefore coextensive in scope with the product claims in the '957 patent, and not patentably distinct. (Office Action at item 8.)

Applicants replied to this rejection by asserting that the pending claims and the claims in the '957 patent were consonant with the restriction requirements made in both applications. (See Reply to Office Action filed September 8, 2005 at pages 8-10.) However, the Office contends that the restriction requirements issued in the '957 patent and the instant case were made between method claims and product claims, not claims 9-11 and 13 of the '957 patent and the pending claims, and that the claims in conflict are both product claims and therefore not consonant with the restriction requirement. (Office Action at item 8.)

Applicants respectfully renew their traversal. Although the Office initially required restriction between method claims and product claims during the prosecution of the '957 patent, the Office reconsidered this restriction, ultimately rejoining some of the product claims into the application. In rejoining these claims, the Office stated the following:

Upon further review, **claims 10, 11, 16, 17, 20, 36, 37, 45, 47 which are drawn to a polynucleotide isolated by the allowed method** and claims 30-34, [and] 46 which are drawn to a method using [a] polynucleotide isolated by the allowed method, previously withdrawn from consideration as a result of a restriction requirement, are now being rejoined because the polynucleotide isolated by the method is the recombinant BAC containing mycobacterium DNA. **Claims 12-15, 18 & 19, which do not depend from or otherwise include all the limitations of the allowable product have not been rejoined.**

(U.S. Application No. 09/060,756, Examiner's Amendment, June 27, 2000, item 1, emphasis added.) On information and belief, claims 10, 11, 16, and 20 in U.S. Application No. 09/060,756 issued as claims 9-11 and 13 in the '957 patent, respectively.

Applicants respectfully submit that the Office thus rejoined only those product claims which were isolated "by the allowed method," and specifically excluded product claims which did not depend from or otherwise include the limitations of allowable claims. Thus, the Office voluntarily withdrew the restriction requirement in the parent case only toward product claims that depended from allowable method claims, but maintained the restriction requirement towards product claims that were independent of the allowed method claims. Applicants now pursue these product claims.

Applicants respectfully submit that the instant claims were not pursued in the '957 patent because the Office judged that these claims could not be pursued in the parent case and restricted them away, while the product claims that issued in the '957 patent did so because the Office determined that these claims were "isolated by the allowed method." Because the instant application was filed in consonance with the restriction requirement in the parent case, it is impermissible to now reject these claims under 35 U.S.C. § 121. See M.P.E.P. § 806.05. Applicants, therefore, request the withdrawal of the obviousness-type double patenting rejection, and the timely allowance of claims 53-56.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Office, and submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Office,

since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Office.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

William B. Reich Reg. No. 54,386

Dated: January 31, 2006

By: 

f.r.: Kenneth J. Meyers
Reg. No. 25,146
Phone: (202) 408-4033
Fax: (202) 408-4400
E-mail: ken.meyers@finnegan.com